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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,064	06/28/2001	Rabindranath Dutta	AUS920010467US1	5457

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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,064

Applicant(s)

DUTTA ET AL.

Examiner

Rob Rhode

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2&3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 21, 28 - 38 and 40 - 46 are rejected under 35 U.S.C. 102(e) as being unpatentable over Shwartz (US 2001/0044787 A1).

Regarding claim 1 and related claims 10, 19, 20, 32, 33 and 46, Schwartz teaches a method and system for effecting transactions between a user and an enterprise wherein said user incurs an obligation to said enterprise, said transactions being authorized based on an anonymous email address, said method comprising: issuing a portable processing device to said user based on said anonymous email address, said portable processing device including input and output means, processing means and memory means, said portable processing device being selectively operable for processing information related to said transaction (see at least Abstract, Page 6, Para 0112 and Figures 1 and 2); programming said portable device to input predetermined conditions related to use of said portable device in effecting said transactions (see at least Page 7,

Para 0119); and interfacing an enterprise computing system with said portable device when said user incurs an obligation using said portable device, said portable device containing said anonymous email address of said user, said anonymous email address being accessible by said enterprise computing system for enabling anonymous communication between said enterprise computing system and said user (see at least Abstract, Page 2, Para 0019, Page 4, Para 0069 and Figure 1). Please note that Schwartz does not specifically disclose anonymous email. However, Schwartz does disclose anonymous/private identifier, which ensures customer anonymity. Thereby, it would have been obvious to one of ordinary skill in the art to have provided the method and system of Schwartz with an anonymous email. In this regard, the user would have the ease of not having to remember another number or account.

Regarding claim 2 and related claim 11, Schwartz teaches a method, wherein said obligation is incurred for the rendering of services (Abstract).

Regarding claim 3 and related claims 12 and 38, Schwartz teaches a method, wherein said obligation comprises a payment for receipt of goods (Page 2, Para 0029).

Regarding claim 4 and related claims 13, 31 and 44, Shwartz teaches a method, wherein said enterprise is a rental enterprise engaged in renting items to users and (5 and 14) wherein said rental enterprise is a media rental enterprise engaged in renting media items to users for limited periods of time, said obligation comprising a

commitment to return said media items by a predetermined time (see at least Abstract). Please note that Shwartz discloses an ecommerce site, which certainly could have been a rental enterprise. Moreover, these rental enterprises were old and well known at the time of the invention, which would have included in the charge for the rental - the requirement to return the item within a predetermined timeframe.

Regarding claim 6 and related claims 15, 30 and 43, the recitation "wherein said enterprise is a library, said obligation comprising a promise to return items borrowed from said library", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "enterprise" already disclosed by Shwartz and Leason.

Regarding claim 7 and related claims 16, 17, 35 and 37, Shwartz teaches a method further including: maintaining a database by said guarantor, said database containing information identifying value of items dispensed to said user from said enterprise, said obligation comprising a commitment to return or pay for said items by a predetermined time (Page 2, Para 0021, Page 3, Para 0048 as well as Page 5, Para 0098).

Regarding claim 8 and related claim 36, Shwartz teaches a method and further including: maintaining a current account of said items, said current account including an initial value balance funded by said user less said replacement value for items currently held by said user (Page 2, Para 0029 & 30 as well as Page, Para 0098).

Regarding claim 9, and related claims 18 and 45, Shwartz teaches a method, wherein said user is enabled to incur said obligation to said enterprise based only on said email address without a disclosure of an identity of said user to said entity (Abstract, Page 3, Para 0039 and Page 4, Para 0069).

Regarding claim 21 and related claim 34, Shwartz teaches a method wherein said portable device comprises a smart card (Page 5, Para 0088). Please note that Shwartz does not specifically disclose a portal device accessible with a smart card. However, this capability was old and well known at the time of the applicant's invention and it would have been obvious to have provided the method and system of Shwartz with the a smart card in order to have provided this complete functionality.

Regarding claim 28 and related claim 41, Shwartz teaches a method wherein said obligation is guaranteed by a guarantor separate from said user and said enterprise (Abstract) and (29 and 42) further including notifying said guarantor by said enterprise computing system when said obligation is not fulfilled (Page 3, Para 0046).

Regarding claim 40, Shwartz teaches a medium, wherein the said portable device is enabled to maintain a record of value of said item dispensed (Page 3, Para 0041 and Page 7, Para 0122).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 – 27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US 2001/0044787 A1) in view of (Webb (US 2002/0143564 B1).

Swartz discloses and teaches substantially the applicant's invention.

Although Shwartz does disclose back office infrastructure, Schwartz does not specifically disclose and teach a method, wherein said interfacing is accomplished by connecting said portable device to an enterprise server system, said enterprise system server being enabled for maintaining an inventory database containing a listing of items available for dispensing in exchange for said obligation nor other functions associated with an inventory system.

On the other hand and regarding claim 22, Webb teaches a method, wherein said interfacing is accomplished by connecting said portable device to an enterprise server system, said enterprise system server being enabled for maintaining an inventory

database containing a listing of items available for dispensing in exchange for said obligation (Page 3, Para 0035 and Figure 1) and (23) wherein said enterprise server system is further enabled for maintaining a balance of said items available after deducting items dispensed and currently in possession of said user (Abstract and Page 3, Para 0035) as well as (24) wherein said inventory server system is further selectively operable for transmitting an identity of said items dispensed to said portable device of said user (Page 2, Para 0023). Moreover and please note that inventory systems and their ability to perform these functions was old and well known at the time of the applicant's invention. In that regard, it would have been obvious to have provided the method and system of Schwartz with an inventory system to have enabled an enterprise server to maintain an inventory database.

Regarding claim 25 and related claims 27 and 39, Webb teaches a method, wherein said portable device is enabled to maintain in said memory means of said portable device, a listing of said items dispensed and (26) wherein said inventory server is further enabled to maintain a record of value of said items dispensed to said user (Figure 1). Please note that it is well known that PDA's do have the capability to store data and that the kind or type of data stored including such specifics as "record of value of items" is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Webb. Thereby, the non-fictional descriptive material is directed only to

the content of the data (i.e. value of items - which is stored data) and does not affect either the structure or method/process of Webb, which leaves the method and system unchanged.

Regarding claim 39, Webb teaches a medium wherein said inventory server system is further enabled to maintain a record of value of said items dispensed to said user (Figure 8)

It would have been obvious to one of ordinary skill at the time of the invention to have provided the method and system of Schwartz with the method and system of Webb to have enabled wherein said interfacing is accomplished by connecting said portable device to an enterprise server system, said enterprise system server being enabled for maintaining an inventory database containing a listing of items available for dispensing in exchange for said obligation nor other functions associated with an inventory system – in order to provide the necessary inventory status. Schwartz discloses a method and system for guaranteeing a transaction by issuing an anonymous email address from a guarantor, which is able to incur obligations and keep track of subsequent transactions for the email address (Abstract, Page 6, Para 0112 and Figures 1 and 2). Webb discloses wherein said interfacing is accomplished by connecting said portable device to an enterprise server system, said enterprise system server being enabled for maintaining an inventory database containing a listing of items available for dispensing in exchange for said obligation (Abstract and Figure 8). Therefore, one of ordinary skill

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in the art would have been motivated to extend the method and system of Shwartz with a method and system wherein said interfacing is accomplished by connecting said portable device to an enterprise server system, said enterprise system server being enabled for maintaining an inventory database containing a listing of items available for dispensing in exchange for said obligation. In that regard, it will relieve the customer of having to remember these items and thereby increase their satisfaction. Moreover, the increased satisfaction with this site will increase the probability that they will recommend the site to others.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Shiloh (US 2001/0037316 A1), which discloses accessing a site with a virtual entity and Leason (US 5,898,594), which discloses prior online orders and rentals as well as Ogasawara (US 6,577,861 B2), which discloses wireless online buying.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450


or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7418 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RER


Jeffrey A. Smith
Primary Examiner